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OCT 11 2007

Amendment
Serial No.: 10/612,784
Attorney Docket No.: ORW01-GN004

REMARKS

Introductory Comments

Claims 1, 2, 4-6, 14, 15, 27-32, 37, and 109 are pending in the present application. Claims 1, 27, and 109 have been amended. Claim 110 has been cancelled. Reconsideration of the application is respectfully requested.

July 19, 2007 Office Action

Rebuttal of Examiner's Response to Applicant's Arguments

Applicant takes exception with the conclusory rationale recited in the two most recent Office actions for rejecting those pending claims. It is the Examiner's responsibility to "provide clear explanations of all actions taken by the examiner during prosecution of an application."¹ Because Applicant traversed the prior art rejections, the Examiner is required to "answer the substance of [those arguments]."² Replying with an improper standard of "one of ordinary skill" as to the sufficiency of a conclusory explanation satisfies neither of those requirements. The Examiner has a duty under M.P.E.P. § 707.07(f) to provide substantive explanation of the rejections of record. The mere conclusions offered by the Examiner do not further prosecution and certainly fail to provide Applicant and the Board of Appeals with sufficient facts upon which to assess the grounds of rejection.

Second, the Examiner concludes that Applicant's rebuttal is contradictory from what was previously thought. This conclusion is incorrect. The Examiner's attention is directed to paragraph [0040] of Applicant's specification which clearly recites:

In the exemplary embodiment utilizing the biologically reabsorbable snap-on augments 26, such augments 26 could be formulated to be absorbed over a relatively short period (i.e., several weeks or months) and could also be formulated so as to be replaced by tissue (such as scar-tissue) that would

¹ M.P.E.P. § 707.07(f)

² M.P.E.P. § 707.07(f)

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provide for long-term hip stability and, hopefully, normal motion. Such formulations of biologic materials are well known by those of ordinary skill in the art.

From this disclosure, it is clear that the augment material "could also be *formulated* so as to be replaced by [scar] tissue," but not necessarily so. Thus, Applicant was free to claim a material that formed scar tissue, but has instead chosen to claim material formulations that do not. See also paragraph [0026] that discloses that the biologically reabsorbable material degrades within, dissolves within, and/or is absorbed by the mammalian body. Applicant's disclosure is not limited to materials necessarily resulting in scar tissue formation, such as taught by Kluber (DE 19716051).

35 U.S.C. §112, Second Paragraph, Rejections

Claims 1, 2, 4-6, 14, 15, 27-32, 37, 109, and 110 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as his invention. This ground of rejection is respectfully traversed.

First, the language "wherein the augment material does not form scar tissue" is not functional and is not ambiguous. The language is clearly not functional, but is rather a result of the formulation of the material. To further clarify this, Applicant has amended the claims to include "formulation" language which provides no other reasonable conclusion than that the "wherein the augment material is formulated not to form scar tissue" is structural, not functional language. Moreover, nothing is ambiguous about this language. Either the augment material is formulated to form scar tissue or it is not. In this case, Applicant claims an augment material that is not formulated to transform into scar tissue.

In addition, it would objectively appear that the Examiner has not closely examined what is claimed. In concluding that "[m]ost foreign material, whether it is absorbable or non-absorbable, can produce scar tissue around it," it is clear that the Examiner is not carefully reading the claim language. Applicant's claims do not speak to whether a substance can form scar tissue *around it*, but rather whether the substance *itself* transforms into scar tissue. In this manner, whether a substance can form scar tissue

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around it is irrelevant. Incidentally, Applicant requests the Examiner to provide objective evidence substantiating his conclusion that "[m]ost foreign material, whether it is absorbable or non-absorbable, can produce scar tissue around it."

The Examiner also insists to improperly rely on speculation in concluding that the PLLA disclosed by Kluber should behave the same way as does the PLLA of Applicant's claims. But as discussed above, Applicant's disclosure instructs that the augments could be formulated so as to form scar-tissue or not.³ In Kluber's case, apparently the PLLA was formulated to turn into scar tissue.

In view of the foregoing, it is respectfully submitted that the 35 U.S.C. §112, second paragraph, rejections should be withdrawn.

As to claim 1 that recites "an acetabular liner having mating features to releasable engage corresponding mating features of an acetabular cup," it is incorrectly alleged by the Examiner that this language is ambiguous as to what elements are being claimed. This rejection is mooted by the cancellation of this limitation from certain pending claims.

As to claim 110 that recites "an acetabular liner including at least one circumferentially oriented recess to releasable engage a corresponding projection of an acetabular cup," it is incorrectly alleged by the Examiner that is ambiguous as to what elements are being claimed. This rejection is also mooted by the cancellation of claim 110.

35 U.S.C. §112, First Paragraph, Rejections

Claims 1, 2, 4-6, 14, 15, 27-32, 37, 109, and 110 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Examiner incorrectly concludes that the claims contain subject matter not described in the specification. This ground of rejection is respectfully traversed.

³ See paragraph [0040] of Applicant's specification.